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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,669	08/03/2001	Nicolaas Cornelius Van Zyl	1918-010967	6713

7590 08/17/2004

Russell D Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818


EXAMINER

SEMUNEGUS, LULIT

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/890,669	Applicant(s) VAN ZYL, NICOLAAS CORNELIUS	
	Examiner Lulit Semunegus	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-28 and 30-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 46 is/are allowed.
- 6) ☒ Claim(s) 24-28, 30 and 42-45 is/are rejected.
- 7) ☐ Claim(s) 31-41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant has amended claim 24 by adding the limitations of the currently canceled claim 29 which previously was objected to as containing allowable subject matter. But, claim 29 contains a recitation of the intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "certain" in claim 24 is a relative term which renders the claim indefinite. The term "certain" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the

Art Unit: 3641

art would not be reasonably apprised of the scope of the invention. It is unclear what certain requirement has to be complied to allow firing of the firearm.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'dwyer (6,477,801) in view of Black (4,835,621).

In regards to claims 24 and 30, O'dwyer teaches a firearm (10) with a safety means for impeding an unauthorized person to fire the firearm (18). Black teaches an information storage means (10) for recording at least one aspect of the group consisting of an image in the direction in which a shot is in use fired, and inherently storing a sound at about the time when a shot is in use fired (col. 1, lines 53-55). At the time of the invention, it would have been obvious to one ordinarily skilled in the art to mount the information storage means (video camera) of Black into the firearm of O'dwyer to record and monitor the shooting action while O'dwyer's teaching shows safety means.

As to claim 25, Black teaches the information storage means (10) storing a unique code relating to each projectile fired (col. 7, lines 43-67).

Claim 24 also contains the term "wherein". The statement of intended use or field of use "wherein" clause are essentially method limitations or statements of intended or desired use. Thus, claim 24 as well as other statements of intended use do

Art Unit: 3641

art would not be reasonably apprised of the scope of the invention. It is unclear what certain requirement has to be complied to allow firing of the firearm.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'dwyer (6,477,801) in view of Black (4,835,621).

In regards to claim 24, O'dwyer teaches a firearm (10) with a safety means for impeding an unauthorized person to fire the firearm (18). Black teaches an information storage means (10) for recording at least one aspect of the group consisting of an image in the direction in which a shot is in use fired, and inherently storing a sound at about the time when a shot is in use fired (col. 1, lines 53-55). At the time of the invention, it would have been obvious to one ordinarily skilled in the art to mount the information storage means (video camera) of Black into the firearm of O'dwyer to record and monitor the shooting action while O'dwyer's teaching shows safety means.

As to claim 25, Black teaches the information storage means (10) storing a unique code relating to each projectile fired (col. 7, lines 43-67).

Claim 24 also contains the term "wherein". The statement of intended use or field of use "wherein" clause are essentially method limitations or statements of intended or desired use. Thus, claim 24 as well as other statements of intended use do

Art Unit: 3641

not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex Parte Masham, 2 USPQ 2nd 1647.

6. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'dwyer (6,477,801) and Black (4,835,621) in view of Eppler (5,062,232). O'dwyer and Black teach all the limitations of claims 26-27 the firearm including a laser system.

As to claim 26, Eppler teaches the firearm includes a laser system for generating a laser beam to ignite a charge to fire a projectile (col. 3, lines 29-35).

As to claim 27, Eppler teaches the firearm includes an electronic system for controlling firing of the firearm (20).

At the time of the invention, it would have been obvious to one ordinary skilled in the art to combine the laser beam of Eppler to O'dwyer and Black invention to accurately aim the projectile.

7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'dwyer (6,477,801) and Black (4,835,621) in view of WO-A-98 55 817 hereafter referred to as D1. O'dwyer and Black teach all the limitations of claim 28 the firearm except a plurality of barrels. D1 teaches the firearm includes a number of barrels (14,15) and wherein the barrels are pre-loaded with projectiles and charges.

At the time of the invention, it would have been obvious to one ordinary skilled in the art to have plurality of barrels as taught in D1 as a design choice since D1 teaches it is well known in the art to have multiple numbers of barrels.

Art Unit: 3641

8. Claim 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'dwyer (6,477,801) and Black (4,835,621) in view of Hope (6,539,661).

O'dwyer and Black teach all the limitations of claims 42-45 including a GPS (O'dwyer, col. 2, lines 36-46). Black and O'dwyer do not expressly teach a digital camera. Hope teaches a digital camera for recording images (col. 4, lines 15-16).

At the time of the invention, it would have been obvious to use Digital camera instead of the video camera as taught by Hope since it is well known in the art that digital camera will function equally well. The motivation of using digital camera would be instant views of the image.

Allowable Subject Matter

9. Claims 31-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 46 is allowed.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


Art Unit: 3641

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lulit Semunegus whose telephone number is (703) 306-5960. The examiner can normally be reached on Mon-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lulit Semunegus
Examiner
Art Unit 3641


JACK KEITH
PRIMARY EXL